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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,538	06/13/2002	Yoichiro Sako	64731	1470
530	7590	12/05/2006		
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER LEMM, SAMSON B	
			ART UNIT 2132	PAPER NUMBER

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,538

Applicant(s)

SAKO ET AL.

Examiner

Samson B. Lemma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,11-15,17,25,34,35,37,39,40,46,51-61,68-72,80,81,85 and 86 is/are rejected.
- 7) ☒ Claim(s) 2,8,10,16,18-24,26-33,36,38,41-45,47-50,62-67,73-79 and 82-84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

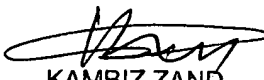
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in reply to an amendment filed on September 06, 2006. All independent claims namely claims 1, 9, 17, 25, 40, 51, 61, 68 and 81 are amended. Applicant pointed out that claims 59-60 were not canceled and therefore they are now considered in this office action. **Therefore claims 1-86** are pending/examined.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119 (a)-(d), which papers have been placed of record in the file.

Response to Arguments

3. Applicant's argument filed on September 06, 2006 have been fully considered but they are not persuasive.

The argument raised by the applicant is with respect to the limitation added to the respective independent claims. Applicant argued that the limitation, "embedding sub data at least into margin bits of said main data based on the format corresponding to said recording medium" is not disclosed by the combination of the references on the record namely, by **Miwa and Kuroda**.

Examiner asserts that such limitation does not have support both in the applicant's specification and the original claims.

On paragraph 0066, of the applicant disclosure, published with the publication number 20020172361, the following has been disclosed.

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“In a second method for partially embedding the sub data to such an extent that there is little influence of the margin bits on the DSV adjustment, the sub data is embedded into only a predetermined data portion of a specified recording pattern. The recording pattern which enables embedding will now be considered.”

Furthermore, on paragraph 0092 of the applicant disclosure published with the publication number 20020172361, the following has been disclosed.

“ FIG. 8 shows another example of this second method. In this example, since a fixed pattern is to be recorded in the sub code area as described above, the fixed pattern is varied in accordance with the type of the disc. The data preceding the sub code area is a synchronizing signal, which is a fixed pattern. Therefore, by controlling the margin bits between the synchronizing signal and the sub code, the sub data can be embedded in accordance with whether, for example, the leading part of the sub code area is a pit or a land.”

The closest support that is found in the disclosure is the following that is stated for instance, in claim 12, “The recording medium as claimed in claim 11, wherein modulation processing is performed on said main data, which is then recorded onto said recording medium, and said sub data is embedded into margin bits of said modulation-processed main data.”

Therefore, it is clear that embedding the sub data into the margin bits of **modulation processed main data** is different **from embedding the sub data into the margin bits of the main data without being modulated or without performing a modulation process on said main data**. These are obviously different and the prior has no support in the original disclosure.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Independent Claims 1, 9, 17, 25, 40, 51, 61, 68 and 81** are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description

requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art

that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Based on a thorough review of the entire disclosure and a text search for

“embedding the sub data into margin bits of the main data”, there is no “readily

apparent support” for the limitation recited as “embedding the sub data into margin

bits of the main data.” The support that is found is the one that is recited in claim 12,

in which the sub data is embedded into margin bits of **said modulation-processed**

main data.” According to the specification what is stated is obvious. That is, before the

sub data is embedded into the margin bits of the main data, the first step is, the

modulation processing is performed on said main data, which is then recorded onto

said recording medium, and finally sub data is embedded into margin bits of said

modulation-processed main data.

6. **Claims 2-8, 10-16, 18-24, 26-39, 41-50, 52-60, 62-67, 69-81 and 82-86**

depend from the rejected independent claims **1, 9, 17, 25, 40, 51, 61, 68 and 81**, and

include all the limitations of the respective claims, thereby rendering those dependent

claims indefinite.

Appropriate correction is required.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1,3-7,9,11-15, 17, 25, 34-35, 37, 39-40, 46, 51-61, 68-72, 80-81**

and 85-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa, Kunihi (hereinafter referred as **Miwa**)(European Publication, EP 0942418 A1), published on 09/15/1999 (submitted with IDS), in view of **Kuroda, Kazuo** (hereinafter referred to as **Kuroda**) (European Publication, EP 0969463 A1), published on 01/05/2000 (submitted with IDS)).

9. **As per claims 1, 9, 17, 25, 40, 51, 59-61, 68,81 and 85-86** **Miwa discloses a recording method for a recording medium,[Abstract, "RAM" or "ROM"]comprising the steps of:**

Recording main data onto a recording medium on which an identification part indicating a type said recording medium provided, so that said main data are readable as optical changes;[paragraph 0011] (management information is met main data and this management information is embedded/recorded on medium of a type such as RAM(rewritable type) or R(write-once type) meets the limitation of an identification part indicating a type said recording medium as it is recited on paragraph 0011)and

Embedding sub data at least into a part of said main data based [paragraph 0013, "additional information is met to be sub data]

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Miwa does not explicitly disclose embedding subdata based on a format corresponding to said type of said recording medium and recording said sub data along with said main data.

However, in the same field of endeavor Kuroda, discloses embedding sub data based on a format corresponding to said type of said recording medium and recording said sub data along with said main data.[paragraph 0005, paragraph 0021-0022] (the type of said recording medium is interpreted as it is recited on the dependent claim 3)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the feature of recording as per teachings of Miwa in to the method **embedding data based on a format corresponding to said type of said recording medium** as taught by **Kuroda**, in order to provide a secure method of prohibiting reproduction of digital information illegally. [see paragraph 0001, the last 2 lines]

10. As per claims 3, 11, 34,46,52-54,69-70,80 the combination of Miwa and Kuroda discloses a method as applied to claims above. Furthermore, Kuroda discloses the recording method wherein said sub data is embedded on the basis of a format corresponding to the type of said recording medium, of at least a first format for a reproduction-only recording medium and a second format for a recordable recording medium. [Paragraph 0021-0022]

11. As per claims 4-7,12-15,35,37,39,55-58,71-72 the combination of Miwa and Kuroda discloses a method as applied to claims above. Furthermore, Miwa discloses the recording method wherein modulation processing is performed on said main data, which is then recorded onto said recording medium, and said sub

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data is embedded into margin bits of said modulation-processed main data.

[Paragraph 0040]

Allowable Subject Matter

12. **Claims 2,8,10,16,18-24,26-33,36,38,41-45,47-50,62-67,73-79 and 82-84**

are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L.

11/20/2006



KAMBIZ ZAND
PRIMARY EXAMINER